

REMARKS

This is a full and timely response to the non-final Official Action mailed October 18, 2010 (the "Office Action" or "Action"). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

Under the imposition of a previous Restriction Requirement, claims 25-30, 34-51, 53-56 and 59-71 were withdrawn. These claims have since been canceled without prejudice or disclaimer. Further original claims 10, 11, 17, 20, 22, 23, 31-33, 57, 58 and 71 had been cancelled without prejudice or disclaimer.

By the preceding amendment, claims 1, 9, 12, and 52 have been amended. Additionally, original claims 2 have been cancelled without prejudice or disclaimer. Thus, claims 1, 3-9, 12-16, 18, 19, 21, 24, 52, and 72-76 are currently pending for further action.

Allowable Subject Matter:

In the outstanding Office Action, the Examiner indicated the presence of allowable subject matter in claims 2 and 6-9. Applicant wishes to thank the Examiner for this identification of allowable subject matter. Accordingly, the subject matter of claim 2 has been added by the present amendment to claim 1, and claim 2 has been cancelled. Therefore, following this amendment, claim 1 should be in condition for allowance based on the identification of allowable subject matter offered by the Examiner.

The recent Office Action does not contain a statement of reasons for the allowance or allowability of claims 2 and 6-9. In any event, Applicant agrees with the Examiner's conclusions regarding the patentability of these claims. Applicant believes that the

application is allowable because the cited references fail to teach, anticipate or render obvious the invention as claimed, independent of how the claims or claimed subject matter may be paraphrased.

Objections to Claims:

In the outstanding Office Action, claims 1 and 12 were objected to because of various informalities. Specifically, the Office Action states that claim 1 should “read (ii) the identity of said sheet.” (Action, p. 7). While Applicant does not necessarily agree that claim 1 was objectionable, claim 1 has been amended herein to address the issues raised by the Examiner. Following this amendment, claim 1 is believed to be beyond objection, and notice to that effect is respectfully requested.

Additionally, the Office Action has indicated that claim 12 should “read using said second printer to convey and identity code to or from said digital paper.” (*Id.*). Applicant specifically notes that the proposed amendment would result in a grammatically incorrect claim. However, claim 12 has been amended for other reasons thereby correcting whatever informality was present thereby rendering the object moot. Following these amendments, claim 12 is believed to be beyond objection, and notice to that effect is respectfully requested.

Rejections under 35 U.S.C. § 112, first paragraph:

In the recent Office Action, claims 1, 12, and 52 were rejected under 35 U.S.C. § 112, first paragraph. These claims have been carefully reviewed in light of the Examiner's comments.

While Applicant does not necessarily agree that any of these claims were not enabled as filed, the indicated claims have been amended herein to address the issues raised by the

Examiner under 35 U.S.C. § 112, first paragraph. Following this amendment, all the remaining claims are believed to be in compliance with 35 U.S.C. § 112 and notice to that effect is respectfully requested.

Rejections under 35 U.S.C. §103(a):

1. In the recent Office Action, claims 1, 3-5, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0122746 to Rignell et al. (hereinafter Rignell) in view of U.S. Patent Application Publication No. 2003/0001020 to Kardach (hereinafter Kardach) in further view of U.S. Patent Application Publication No. 2002/0050982 to Ericson (hereinafter Ericson). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 1:

Claim 1 now recites:

A method of associating in computer memory (i) a digital electronic version of printed human-discernible content of a printed document comprising a sheet having a machine-readable pattern adapted to enable the position of a digital pattern reading device to be determined and said human-discernible content with (ii) the identity of said sheet upon which the content is printed, the method comprising:

printing the content onto a sheet using a second printer, said sheet comprising a pre-patterned sheet that has been pre-printed by a first printer with said pattern;

in which said first printer has a higher print resolution than the second printer;

associating a machine-readable identity code with said sheet at around the time of printing said human-discernible content, ***wherein said identity code is read from said sheet by said second printer***; and

storing a correlation between said identity code and said digital electronic version of printed human-discernible content in computer memory.

(Emphasis added).

Applicant would like to point out that the subject matter of claim 2 has been added to claim 1 by the present amendment. Support for the amendment to claim 1 can be found in Applicant's originally filed specification at, for example, page 33, ll. 4-15; page 39, lines 13-25, and page 39, line 30 through p. 40, line 7.

In contrast, Rignell, Kardach, Ericson, or any combination thereof does not teach or suggests the method of claim 1 "comprising: . . . associating a machine-readable identity code with said sheet at around the time of printing said human-discernable content, wherein said identity code is read from said sheet by said second printer." (Claim 1). Therefore, for at least this reason the rejection of claim 1 should be reconsidered and withdrawn.

2. In the recent Office Action, claims 6-9 were indicated as being rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0122746 to Rignell et al. (hereinafter Rignell) in view of U.S. Patent Application Publication No. 2003/0001020 to Kardach (hereinafter Kardach) in further view of U.S. Patent Application Publication No. 2002/0050982 to Ericson (hereinafter Ericson) in further view of U.S. Patent No. 7,111,230 to Euchner et al (hereinafter Euchner). However, the Office Action has also indicated that "Applicant's arguments, see pages 2-16, filed 07/19/10, with respect to claims 2 and 6-9 have been fully considered and are persuasive. The 103(a) of 03/22/10 has been withdrawn." (Action, p. 6). In order to clarify this rejection, a representative for the Applicant contacted the Examiner on December 22, 2010 at 1:10 p.m. (MST), upon which the Examiner had indicated that the rejection of claims 6-9 had indeed been withdrawn and that the rejections of claims 6-9 shown on pages 13 – 16 were mistakenly added the Examiner's arguments due to a simple clerical error. Therefore, Applicant is

treating the rejections of claims 6-9 on pages 13-16 of the Action as moot in light the allowance of these claims and the telephonic conversation.

3. In the recent Office Action, claims 12, 13, 14-16, 18, 19, 21, 52, 75, and 76 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0122746 to Rignell et al. (hereinafter Rignell) in view of U.S. Patent Application Publication No. 2003/0001020 to Kardach (hereinafter Kardach) in further view of U.S. Patent No. 7,111,230 to Euchner (hereinafter Euchner). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 12:

Claim 12 now recites:

A method of associating in computer memory a digital electronic version of printed human discernible content of a printed document with an identity code adapted to identify said document, the method comprising:
using a plurality of pages of pre-patterned digital paper that have been pre-printed by a first printer with a position-determining pattern, said pattern being adapted to enable a digital pen to acquire information from said pattern to enable the position of said pen on said pattern to be determined;
printing said content on said digital paper using a second printer;
using said second printer to associate an identity code with the digital paper;

in which said identity code is a user-specific identity code and in which, upon recognition of said user-specific identity code, said second printer is caused to print user-specific personal details about the user along with said human discernible content onto said pre-printed digital paper; and

associating in computer memory, using said code, at the time of printing said content onto said pre-patterned paper, a digital electronic version of said content with the identity code for the particular sheet of digital paper upon which said content is printed.

(Emphasis added).

Support for the amendment to claim 12 can be found in Applicant's originally filed specification at, for example, p. 49, l. 23 – p.50, l. 13.

In contrast, Rignell, Kardach, Euchner, or any combination thereof does not teach or suggest the method of claim 12,

the method comprising: . . . using said second printer to associate an identity code with the digital paper; in which said identity code is a user-specific identity code and in which, upon recognition of said user-specific identity code, said second printer is caused to print user-specific personal details about the user along with said human discernible content onto said pre-printed digital paper.
(Claim 12).

The Office Action concedes that “Rignell does not teach . . . in which said identity code is a user-specific identity code and in which, upon recognition of said user-specific identity code, said second printer is caused to print user-specific content along with said human discernible content onto said pre-printed digital paper.” (Action, p. 17). The Office Action therefore relies on Euchner and asserts that Euchner teaches these features. However, the Office Action has further pointed out that “[t]here is no limitation in the claim that states that information about the user is printed with the content of the page, only that the identity code which identifies the user is printed with the content.” (*Id.* at p. 18).

However, claim 12 as amended now includes the recitation of “user-specific personal details about the user.” (Claim 12). Nowhere in Euchner is it taught or suggested that “upon recognition of said identity code, said second printer is caused to print user-specific personal details about the user along with said human discernible content.” (*Id.*).

The Supreme Court has addressed the issue of obviousness in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). The Court stated that the *Graham v. John Deere Co. of Kansas City*, 383, U.S. 1 (1966), factors still control an obviousness inquiry. Under the analysis required by *Graham* to support a rejection under § 103, the scope and content of the prior art

must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the cited references did not include the claimed subject matter, particularly a method of associating in computer memory a digital electronic version of printed human discernible content of a printed document with an identity code adapted to identify said document, the method comprising using said second printer to associate an identity code with the digital paper in which said identity code is a user-specific identity code and in which, upon recognition of said user-specific identity code, said second printer is caused to print user-specific personal details about the user along with said human discernible content onto said pre-printed digital paper.

The differences between the cited references and claim 12 are significant because claim 12 provides for a pre-filled form complete with the user's personal details inserted into the appropriate fields of the printed human discernable content. Thus, the claimed subject matter provides features and advantages not known or available in the cited references. Consequently, the cited references will not support a rejection of claim 12 under 35 U.S.C. § 103 and *Graham*.

Claim 52:

Claim 52 now recites:

A method of combining pen strokes made with a digital pen upon a digital sheet having pen position-determining pattern printed upon it and human-discernible content printed upon it comprising:

- printing said sheet with said pattern in a pre-patterning operation with a first printer to create a pre-patterned sheet;
- subsequently printing said content onto said pre-patterned sheet using a second printer to create a content-printed digital sheet;
- with said second printer, printing an identity code on ~~and~~ said sheet to enable the identity of said sheet to be established in a subsequent pen-on-sheet

writing operation, the printing of said identity code occurring in the same time frame as printing said content onto said sheet;

in which said second printer further comprises a pattern reading device wherein said pattern reading device scans said pre-printed pattern on the said sheet in order to enable the pattern on said sheet to be identified;

in which said identity code corresponds to a predetermined set of human-discernible content and in which, upon recognition of said identity code, said second printer is caused to print user-specific content along with said predetermined set of human-discernible content onto said pre-printed digital paper;

associating in computer memory a link between said identity code and an electronic version of said content that was printed on said sheet;

using a digital pen to make pen strokes on said content-printed sheet;

conveying said pen-acquired pen-position data, relating to the position of said pen in said pattern to a processor;

using the digital pen to acquire said identity code from said content-printed sheet;

the processor using the pen-acquired identity code, the pen acquired pen-position data, and the link between said identity code and said electronic version of said content to combine said pen strokes with said content.

(Emphasis added).

Support for the amendment to claim 52 can be found in Applicant's originally filed specification at, for example, page 33, lines 4-15; page 39, lines 13-25, and page 39, line 30 through p. 40, line 7 as well as originally filed claim 6.

In contrast, Rignell, Kardach, Euchner, or any combination thereof do not teach or suggest a method of combining pen strokes made with a digital pen with human-discernable content printed on a digital sheet comprising "with said second printer, scanning an identity code on said sheet to enable the identity of said sheet to be established in a subsequent pen-on-sheet writing operation, the scanning of said identity code occurring in the same time frame as printing said content onto said sheet." (Claim 52). Applicant notes that, in the final Office Action of March 22, 2010, it was admitted that "Rignell in view of Kardach further in view of Ericson does not teach wherein the second printer which prints said content onto said pre-patterned sheet has a pattern reading device." (Final Office Action of March 22, 2010, p.

8). Additionally, Euchner also fails to teach or suggest “a pattern reading device,” and instead teaches “*a digital pen or other pattern scanner* is used to identify the paper *before it is placed* in the traditional printer.” (Euchner, col. 9, ll. 32-34) (emphasis added). Clearly, the combination of the cited references fails to teach or suggest a printer comprising a pattern reading device which scans the pre-printed pattern on the sheet.

Again, the Court stated that the *Graham v. John Deere Co. of Kansas City*, 383, U.S. 1 (1966), factors still control an obviousness inquiry. Under the analysis required by *Graham* to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the cited references did not include the claimed subject matter, particularly a method of combining pen strokes made with a digital pen upon a digital sheet having pen position-determining pattern printed upon it and human-discernible content printed upon it in which a second printer further comprises a pattern reading device wherein said pattern reading device scans a pre-printed pattern on the a digital sheet in order to enable the pattern on the sheet to be identified.

The differences between the cited references and claim 52 are significant because claim 52 provides for the development of data related to the location of the form-specific fixed content associated with the identified region of digital pattern thereby allowing the processor using the pen-acquired identity code, the pen acquired pen-position data, and the link between said identity code and said electronic version of said content to combine said pen strokes with said content. Thus, the claimed subject matter provides features and advantages not known or available in the cited references. Consequently, the cited references will not support a rejection of claim 52 under 35 U.S.C. § 103 and *Graham*.

Additionally, various dependent claims of the application recite subject matter that is further patentable over the cited prior art. Specific, non-exclusive examples follow.

Claim 14:

Claim 14 recites:

A method according to claim 12 wherein an identity code adapted to distinguish a specific sheet of pre-patterned digital pattern is printed on said specific sheet in an operation prior to printing said content onto said specific sheet, and *wherein a second printer which prints said content onto said pre-patterned paper has an identity code reading device, said second printer being capable of acquiring data from said identity code*, said identity code being capable of being used to distinguish data acquired by a digital pen from said specific sheet from data acquired by said pen from other sheets of pre-patterned paper having the same position-determining pattern on them as does said specific sheet, to enable said association to be made between said digital electronic version of said content and said identity code.

(Emphasis added).

In contrast, Rignell, Kardach, Euchner, or any combination thereof do not teach or suggest “a second printer which prints said content onto said pre-patterned paper has an identity code reading device, said second printer being capable of acquiring data from said identity code.” (Claim 14). The Office Action concedes that “Rignell in view of Kardach does not teach . . . wherein a second printer which prints said content onto said pre-patterned paper has an identity code reading device, said second printer being capable of acquiring data from said identity code.” (Action, p. 20). In order to overcome this deficiency, the Office Action relies on Euchner. However, Euchner at best teaches that “each page of the digital paper may use a different pattern space and may be scanned as printed.” (Euchner, col. 9, ll. 24-26). Nowhere does Euchner teach that a second printer has an identity code reading device as recited in claim 14. Indeed, Euchner goes on further to teach that “[i]n order to associate a particular sheet of digital paper with the electronic master document, *a digital pen*

or other pattern scanner is used to identify the paper *before it is placed in the traditional printer.*" (*Id.* at 11. 31-34) (emphasis added). Clearly, this is not taught in Euchner. To be sure, Euchner teaches away from the recitations of claim 14 by requiring the use of "a digital pen or other pattern scanner" instead of a printer in order to scan the sheets. (*Id.*).

Again, the Court stated that the *Graham v. John Deere Co. of Kansas City*, 383, U.S. 1 (1966), factors still control an obviousness inquiry. Under the analysis required by *Graham* to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the cited references did not include the claimed subject matter, particularly a second printer which prints said content onto said pre-patterned paper having an identity code reading device, said second printer being capable of acquiring data from said identity code.

The differences between the cited references and claim 14 are significant because claim 14 provides for a scanner on the second printer so as to enable the identity of any specific sheet of digital paper to be automatically established thereby associating the electronic version of the human-discernable content to the paper on which it is printed at the time of printing the content. Thus, the claimed subject matter provides features and advantages not known or available in the cited references. Consequently, the cited references will not support a rejection of claim 14 under 35 U.S.C. § 103 and *Graham*.

Claim 21:

Claim 21 recites:

A method according to claim 12 wherein said second printer is (i) not capable of printing said pattern satisfactorily; or (ii) configured not to be capable of printing said pattern satisfactorily.

(Emphasis added).

In contrast, Rignell, Kardach, Euchner, or any combination thereof do not teach or suggest “wherein said second printer is (i) not capable of printing said pattern satisfactorily; or (ii) configured not to be capable of printing said pattern satisfactorily.” (Claim 21).

In rejecting claim 21, the Office relies solely on Rignell citing only to paragraph 22 found therein. However, at best, Rignell teaches that “a product can easily be produced by applying graphics to the substrate. This can be carried out by means of a conventional printer or copying machine.” (Rignell, para. [0022]). Nowhere does Rignell teach or suggest that the printer is not capable of printing the pattern satisfactorily or that it is configured to not be capable of doing so. Therefore the recitations of claim 21 are clearly not taught or suggested in Rignell.

Again, the Court stated that the *Graham v. John Deere Co. of Kansas City*, 383, U.S. 1 (1966), factors still control an obviousness inquiry. Under the analysis required by *Graham* to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the cited references did not include the claimed subject matter, particularly wherein said second printer is (i) not capable of printing said pattern satisfactorily; or (ii) configured not to be capable of printing said pattern satisfactorily.

The differences between the cited references and claim 21 are significant because recitation of claim 21 provides for the use of a printer having lower resolution to print the human-discernable content on the paper while still making use of the pre-printed pattern on the paper. Thus, the claimed subject matter provides features and advantages not known or available in the cited references. Consequently, the cited references will not support a rejection of claim 21 under 35 U.S.C. § 103 and *Graham*.

4. In the recent Office Action, claim 72 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0122746 to Rignell et al. (hereinafter Rignell) in view of U.S. Patent Application Publication No. 2003/0001020 to Kardach (hereinafter Kardach) in further view of U.S. Patent Application Publication No. 2002/0050982 to Ericson (hereinafter Ericson) in further view of U.S. Patent No. 7,050,181 to Korst et al (hereinafter Korst). The rejection of claim 72 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claims 1.

5. In the recent Office Action, claims 73 and 74 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0122746 to Rignell et al. (hereinafter Rignell) in view of U.S. Patent Application Publication No. 2003/0001020 to Kardach (hereinafter Kardach) in further view of U.S. Patent No. 7,111,230 to Euchner (hereinafter Euchner) in further view of U.S. Patent No. 7,050,181 to Korst et al (hereinafter Korst). The rejection of claims 73 and 74 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claims 12 and 52.

Conclusion:

In view of the preceding arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue, or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

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